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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,953	04/30/2001	Terry Wayne Liles	16356.605 (DC-02889)	3329
27683	7590	09/12/2006	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			YIGDALL, MICHAEL J	
			ART UNIT	PAPER NUMBER
			2192	

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/845,953	Applicant(s) LILES ET AL.	
	Examiner Michael J. Yigdall	Art Unit 2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-12, 14-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-12, 14-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 23, 2006 has been entered. Claims 1-3, 5-12, 14-21 and 23-28 are pending.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive.

At the outset, it is noted that similar arguments were presented in Applicant's submission filed on February 7, 2005. These arguments were addressed in the Office action mailed on July 5, 2005. Applicant presented similar arguments again in the submission filed on October 4, 2005. As noted in the following Office action mailed on December 29, 2005, these arguments do not comply with 37 CFR 1.111(b) and (c).

Applicant makes a broad and general statement that the combination of Fontanesi and van Gilluwe does not teach the subject matter recited in independent claims 1, 10, 19 and 28 (remarks, page 9, first and second paragraphs). Applicant also makes a broad and general statement that the references do not teach or suggest the desirability of the combination, nor provide any incentive or motivation supporting the desirability of the combination (remarks, page 10, second paragraph). Finally, Applicant concludes that the combination of references arises solely from hindsight (remarks, page 11, last paragraph).

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However, Applicant does not specifically point out how the language of the claims patentably distinguishes them from the references, as per 37 CFR 1.111(b). Likewise, Applicant does not point out the patentable novelty that Applicant thinks the claims present in view of the references, as per 37 CFR 1.111(c). Accordingly, without more, the examiner's positions are maintained, as presented in the claim rejections below.

Nonetheless, in response to Applicant's arguments, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, a teaching, suggestion or motivation to combine the teachings of Fontanesi and van Gilluwe, found within the references themselves and within the general knowledge of those of ordinary skill in the art at the time of the invention, is again presented in the claim rejections below. Applicant has not addressed the examiner's reasoning or provided any evidence of nonobviousness.

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In response to Applicant's list of "shortcomings" in the teachings of Fontanesi and van Gilluwe (remarks, page 10, bottom), these statements are extracted from the Office action and presented out of context. In particular, with respect to statements 2 and 3 (remarks, page 11, top), these statements were made to illustrate that identifying a location on the storage device is an inherent teaching in Fontanesi. As presented in the Office action, Fontanesi does disclose storing an image file on the storage device, and does disclose partitioning the storage device. These are not shortcomings. Because Fontanesi must identify locations on the storage device at which to perform these operations, identifying a location on the storage device is an inherent teaching. The Office action set forth a *prima facie* case of obviousness for identifying the location on the storage device as a sector offset.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-12, 14-21 and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,681,323 to Fontanesi et al. (art of record, "Fontanesi") in view of U.S. Patent No. 6,351,850 to van Gilluwe et al. (art of record, "van Gilluwe").

With respect to claim 1 (previously presented), Fontanesi discloses a method performed by a computer system (see, for example, the abstract) comprising:

(a) configuring a memory to store a control process (see, for example, column 4, lines 24-34, which shows configuring a memory of an installation server with programs and procedures to control installation, i.e. a control process).

Although Fontanesi discloses determining the size of a storage device (see, for example, column 6, lines 51-55), Fontanesi does not expressly disclose:

(b) in response to a size of a storage device, identifying a sector offset on the storage device.

However, Fontanesi further discloses partitioning the storage device (see, for example, column 6, lines 42-58), formatting the storage device (see, for example, column 6, line 59 to column 7, line 4), and storing and installing an image file on the storage device (see, for example, column 7, lines 5-25), among other operations. Inherently, Fontanesi must identify a location on the storage device with which to perform each of these operations. For example, Fontanesi cannot store an image file on the storage device, as disclosed, without first identifying a location at which to store the image file. Likewise, Fontanesi cannot partition the storage device, as disclosed, without first identifying a location at which to do so. Thus, Fontanesi teaches identifying a location on the storage device.

Although the identified location on the storage device is not expressly a sector offset, van Gilluwe discloses identifying the number of sectors and the number and location of each partition on a storage device (see, for example, column 6, lines 17-34). The sectors are numbered based on a reference point (see, for example, column 2, lines 12-15), which is to say that the sector numbers are offsets from the reference point. Van Gilluwe further discloses that

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the sector numbers, or in other words, the sector offsets, identify unique locations on the storage device (see, for example, column 2, lines 15-25).

Moreover, van Gilluwe expressly discloses determining the size of each partition and the amount of free space in each partition when identifying the location of a partition (see, for example, column 6, lines 17-34). Thus, van Gilluwe teaches identifying a sector offset of a partition in response to a size of the storage device, such as the size of each partition. Indeed, it may be the case that there are no existing partition boundaries on the storage device (see, for example, column 6, lines 17-34). In such cases, van Gilluwe discloses performing the necessary partitioning actions on the storage device, such as adding and creating a new partition (see, for example, column 8, lines 6-14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Fontanesi with the features taught by van Gilluwe, so that the location at which to store an image file and the location at which to partition the storage device, for example, can be identified based on the characteristics of the storage device. Fontanesi and van Gilluwe are both directed toward the installation of an operating system (see, for example, the abstracts). Accordingly, the combination of Fontanesi and van Gilluwe is also desirable because, as disclosed by van Gilluwe, identifying the characteristics of the storage device enables one to determine whether it is even possible to install the operating system on the storage device (see, for example, column 6, lines 35-49).

Therefore, Fontanesi in view of van Gilluwe teaches, in response to a size of a storage device, identifying a sector offset on the storage device.

Fontanesi in view of van Gilluwe further discloses:

(c) determining the sector offset by the control process prior to an operating system being installed on the computer system and prior to the storage device being partitioned (see, for example, Fontanesi, column 5, lines 20-24, which shows that an operating system is not yet installed on the computer system, and column 6, lines 42-58, which shows that the characteristics of the storage device are determined prior to partitioning the storage device);

(d) storing an image onto the storage device at the sector offset by copying the image from the memory to the storage device (see, for example, Fontanesi, column 7, lines 5-25, which shows copying and storing an image file onto the storage device from the memory of the installation server, and column 4, lines 1-23, which further shows that the image includes an operating system).

Note that as presented above, Fontanesi cannot store an image file on the storage device without first identifying a location at which to store the image file. Thus, Fontanesi teaches identifying a location on the storage device, and subsequently storing an image onto the storage device at the identified location. In view of van Gilluwe, the location is identified in terms of a sector offset.

(e) providing the sector offset to an installation engine (see, for example, Fontanesi, column 5, lines 25-38, which shows a boot storage medium for installing the operating system, i.e. an installation engine).

Again, the location on the storage device, identified in terms of a sector offset, is inherently provided to the installation engine so that it can operate.

(f) subsequent to storing the image on the storage device, initiating the installation engine to cause the operating system to be installed on the storage device using the image (see, for

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example, Fontanesi, column 7, lines 5-25, which shows installing and configuring the operating system from the image file subsequent to copying and storing the image onto the storage device).

With respect to claim 2 (original), Fontanesi in view of van Gilluwe further discloses, subsequent to initiating the installation engine, partitioning the storage device (see, for example, Fontanesi, column 5, lines 39-50, which shows initiating the installation engine, and column 6, lines 42-58, which shows subsequently partitioning the storage device).

With respect to claim 3 (original), Fontanesi in view of van Gilluwe further discloses, subsequent to initiating the installation engine, performing a formatting operation on the storage device (see, for example, Fontanesi, column 5, lines 39-50, which shows initiating the installation engine, and column 6, line 59 to column 7, line 4, which shows subsequently formatting the storage device).

With respect to claim 5 (original), Fontanesi in view of van Gilluwe further discloses identifying the sector offset in response to a size of the image (see, for example, van Gilluwe, column 6, lines 35-49, which shows determining whether the operating system can be installed based on the size of the operating system).

With respect to claim 6 (original), Fontanesi in view of van Gilluwe further discloses providing the sector offset to the installation engine by storing the sector offset in a predetermined location on the storage device (see, for example, van Gilluwe, column 6, lines 17-34, which shows that the characteristics of the storage device are stored on the storage device,

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i.e. at a predetermined location, and Fontanesi, column 5, lines 53-61, which further shows storing a value at a predetermined location on the storage device).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the location or the sector offset to the installation engine by storing it in a predetermined location on the storage device, so that the sector offset can be maintained even in the event of a reboot (see, for example, Fontanesi, column 5, lines 53-61) or a power failure (see, for example, van Gilluwe, column 8, lines 21-32).

With respect to claim 7 (original), although Fontanesi discloses program logic, i.e. procedures and functions, for installing the operating system on the storage device (see, for example, column 5, lines 39-50), Fontanesi in view of van Gilluwe does not expressly disclose providing the sector offset to the installation engine by passing the sector offset as part of a function call to initiate the installation engine.

However, passing a parameter as part of a function call is notoriously well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the location or sector offset to the installation engine by passing it as part of a function call, as is known in the art.

With respect to claim 8 (original), Fontanesi in view of van Gilluwe further discloses storing the image onto the storage device by copying the image from a CD-ROM (see, for example, Fontanesi, column 7, line 66 to column 8, line 11, which shows transferring the image file from a CD-ROM).

With respect to claim 9 (original), Fontanesi in view of van Gilluwe further discloses storing the image onto the storage device by copying the image over a network (see, for example, Fontanesi, column 7, line 66 to column 8, line 11, which shows transferring the image file from the installation server over a LAN).

With respect to claim 10 (previously presented) and claims 11, 12 and 14-18 (original), the claims recite a computer program product that corresponds to the method recited in claims 1-3 and 5-9, respectively (see the rejections of claims 1-3 and 5-9 above). Note that Fontanesi further discloses a computer program product comprising a computer program processable by a computer system and an apparatus from which the computer program is accessible by the computer system (see, for example, column 5, lines 25-50 and column 8, lines 12-15).

With respect to claim 19 (previously presented) and claims 20, 21 and 23-27 (original), the claims recite a system that corresponds to the method recited in claims 1-3 and 5-9, respectively (see the rejections of claims 1-3 and 5-9 above). Note that Fontanesi further discloses a system comprising a computer system (see, for example, FIG. 1).

With respect to claim 28 (previously presented), the limitations recited in the claim are analogous to those of claims 1, 3, 6 and 9 (see the rejections of claims 1, 3, 6 and 9 above).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (571) 272-3707. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MY

Michael J. Yigdall
Examiner
Art Unit 2192

mjy



TUAN DAM
SUPERVISORY PATENT EXAMINER